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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,061	01/24/2000	Yoshiki Kawaoka	0905-0226P-SP	6688
7590 06/16/2006 Birch Stewart Kolasch & Birch LLP P O Box 747 Falls Church, VA 22040-0747			EXAMINER PHAM, HUNG Q	
			ART UNIT 2168	PAPER NUMBER

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/490,061	<b>Applicant(s)</b> KAWAOKA, YOSHIKI	
	<b>Examiner</b> HUNG Q. PHAM	<b>Art Unit</b> 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 7-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/06/2006 has been entered.

### *Response to Arguments*

- **§ 112, 1<sup>st</sup> Paragraph Rejection**

Applicants' arguments with respect to the rejection of claims 14 and 18 under 35 U.S.C. § 112, first paragraph have been fully considered but they are not persuasive. As shown in FIG. 2, the image files are consecutively numbered in the second loadable and removable recording medium when the image files are read from the first medium. FIG. 2 cannot be perceived as the image files are consecutively numbered in the second loadable and removable recording medium regardless even the image files are read from the first medium.

In light of the foregoing arguments, the 35 U.S.C. § 112, first paragraph, is hereby sustained.

- **§ 103 Rejection - *Shiota***

Applicants' arguments with respect to the rejection of claims 7-20 under 35 U.S.C. § 103 have been fully considered but they are not persuasive.

As argued by applicants:

(a) At page 9, lines 2-10:

*... Applicant amply demonstrated that at best, Shiota merely discloses keeping a count - i.e., a reception number - of the memory cards loaded into the system. Thus, the counter merely identifies the memory card. The Examiner alleges that the memory card is equivalent to the first loadable and removable recording medium as recited. Thus, even under the Examiner's interpretation, Shiota merely discloses keeping track of an identity of the first recording medium. Shiota does not teach or suggest the feature of reading-out the last file number of the image files that are recorded on the second loadable and recording medium. This is sufficient to distinguish claim 7 from Shiota.*

(b) From page 9, line 17 to page 10, line 3:

*Regardless, claim 7 clearly recites that the second recording medium is loadable and removable. There is no indication, and indeed the Examiner did not even allege, that Shiota discloses a loadable recording medium as the second recording medium. Indeed, observation of Figure 1 of Shiota, and more specifically, the laboratory system 4 as illustrated in Figure 1, does not even contemplate a loadable recording medium. Therefore, Shiota does not teach or suggest, and indeed teaches away from, the feature of the second loadable and removable recording medium. Clearly, independent claim 7 is distinguishable over Shiota.*

(c) At page 11, lines 4-13:

*Independent claim 10 recites, in part "reading-out a last file-number of file-numbers for image files that have been recorded on the second loadable and removable recording medium" and "changing a file name of the image file that has been read-out of the first loadable and removable recording medium to the incremented file-number and recording the read image file on the second loadable and removable recording medium." As demonstrated above, claim 10 is distinguishable over Shiota.*

*Claims 8-9 and 11-20 depend from independent claims 7 and 10 directly or indirectly. Therefore, for at least due to the dependency thereon, these dependent claims are also distinguishable over Shiota.*

Examiner respectfully disagrees.

(a) The claimed limitation as recited in claim 7 cannot be interpreted as argued by applicants: *reading-out the last file number of the image files that are recorded on the second loadable and recording medium. Claim 7 recited a last file-number of file-numbers is read out, and the file-numbers concerning image files that have been recorded on the second recording medium (reading out a last file-*

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*number of file-numbers for image files that have been recorded on the second recording medium*). Thus, the *last file-number of file-numbers for image files* cannot be interpreted as *last file number of the image files*.

As disclosed by Shiota, if the method is carried out by a system in a laboratory rather than a personal computer, a counter is used for counting a 4 digits reception number. Every time one memory card is accepted, the counter is incremented and the identifying number is assigned by a combination of the reception number and a serial number, e.g., if “flower04030001001” to “flower040300010010” are from the first memory card, the first file name of the second memory card is “flower04030002001” (Col. 7, Lines 18-35). As seen, when the first memory card accepted, the previous reception number was 0000 and the counter incremented 0000 by one to have 0001 as the reception number for the first memory card. In order to have the reception number for the second memory card, e.g., 0002, the counter retrieves the previous reception number, e.g., 0001, and increments by one. Thus, the previous reception number, e.g., 0001, as *a last file number of a plurality of reception numbers*, e.g., 0000 and 0001, as *file numbers* is read out and incremented, and these *file numbers* concerning (for) *image files that have been recorded on the second recording medium*, e.g., “flower04030001001” to “flower040300010010”. In short, the Shiota discloses the claimed limitation *reading out a last file-number of file-numbers for image files that have been recorded on the second recording medium*.

(b) As indicated in the previous Office Action, examiner admitted that Shiota fails to disclose the second recording medium is *loadable and removable*. However, Shiota uses a conventional computer as the device for processing image files. The conventional computer as disclosed, obviously, has a loadable and removable recording medium such as floppy disk or CD. Shiota further makes a strong suggestion, the picture image filing device specifically means, for example a printing system having the above function and set in a laboratory, a

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personal computer, a work station or the like (Col. 4, lines 1-5). Thus, instead of processing in a hard drive, a loadable and removable recording medium such as a high capacity disk could be used for storing, e.g., CD. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Shiota device by including a second loadable and removable recording medium when processing the image files from a first storage medium in order to have a more user-friendly environment by giving drive options for storing data such as a displaying of selection including C, A, and E drive to the users when processing the image from a digital camera or a memory card of digital camera.

(c) Claim 10 recited similar subject matters as discussed above with respect to claim 7. Therefore, claim 10 is not distinguishable over Shiota.

Claims 8-9 and 11-20 depend from independent claims 7 and 10 directly or indirectly. Therefore, these dependent claims are also unpatentable for at least due to the dependency thereon.

In light of the foregoing arguments, the rejection under 35 U.S.C. § 103 is hereby sustained.

### ***Claim Objections***

Claims 13 and 17 are objected to because of the following informalities: *the files* at line 3 (*the image files* is suggested). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 14 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

As in claim 14 and 18, the claimed *the numerical characters of the file names of the files are consecutively numbered regardless even when image files from a plurality of first loadable and removable recording mediums are read out and recorded on the second loadable and removable recording medium* WAS not described in the specification.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 7-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al. [EP 0 838 767 A2].**

Regarding claims 7 and 10, Shiota teaches a method and device for *reading out an image file that has been recorded on a first loadable and removable recording medium and recording said image file on a second recording medium* (Shiota, Col. 1, Lines 6-15), comprising the steps of:

*reading out a last file-number of file-numbers for image files that have been recorded on the second recording medium, and incrementing the read out last file-number* (As illustrated at Col. 7, Lines 18-35, a laboratory system implies *a second recording medium* is included in the system. As illustrated at Col. 7, Lines 18-35, if the method is carried out by a system in a laboratory rather than a personal computer, a counter is used for counting a reception number. Every time one memory card is accepted, the counter is incremented and the identifying number is assigned by a combination of the reception number and a serial number, e.g., if “flower04030001001” to “flower040300010010” are from the first memory card, the first file name of the second memory card is “flower04030002001”. As seen, when the first memory card is accepted in the system, the reception number at that time is 0000 and the counter increments 0000 by one to have 0001 as the reception number for the first memory card. In order to have the reception number for the second memory card, e.g., 0002, the counter retrieves the previous reception number, e.g., 0001, and increments the previous reception number by one. Thus, the previous reception number, e.g., 0001, as *a last file number of a plurality of reception numbers*, e.g., 0000 and 0001, as *file numbers* is read out and incremented, and these *file numbers* concerning (for) *image files that have been recorded on the second recording medium*, e.g., “flower04030001001” to “flower04030001010”. In short, the Shiota discloses the claimed limitation *reading out a last file-number of file-numbers for image files that have been recorded on the second recording medium*);

*changing a file name of the image file that has been read out of the first loadable and removable recording medium to the incremented file-number and recording the read image file on the second recording medium* (Col. 6, Lines 12-25, *flower0403* as a file name of the image file that has been read out from a



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memory card as *the first loadable and removable recording medium* is changed to *flower04030002001* as *the incremented file-number*, and recorded in laboratory system as *the second recording medium*) *without checking for duplicate file names in the second recording medium* (Col. 7, Lines 25-28),

*wherein the file name includes numerical characters* (Col. 6, Lines 12-25, e.g., *flower0403*).

Shiota fails to disclose the second recording medium is *loadable and removable*. However, Shiota uses a conventional computer as the device for processing image files. The conventional computer as disclosed, obviously, has a loadable and removable recording medium such as floppy disk or CD. Shiota further makes a strong suggestion, the picture image filing device specifically means, for example a printing system having the above function and set in a laboratory, a personal computer, a work station or the like (Col. 4, lines 1-5). Thus, instead of processing in a hard drive, a loadable and removable recording medium such as a high capacity disk could be used for storing, e.g., CD.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Shiota device by including a second loadable and removable recording medium when processing the image files from a first storage medium in order to have a more user-friendly environment by giving drive options for storing data such as a displaying of selection including C, A, and E drive to the users when processing the image from a digital camera or a memory card of digital camera.

Regarding claims 8 and 11, Shiota teaches all the claimed subject matters as discussed in claims 7 and 10, Shiota further discloses the steps of *grouping image files, which have been recorded on the second loadable and removable recording medium according to the types of images represented by the image files* (Col. 5, line 49-Col. 6, line 7).

Regarding claims 9 and 12, Shiota teaches all the claimed subject matters as discussed in claims 8 and 11, Shiota further discloses the step of *recording a file name corresponding to each group on the second loadable and removable recording medium* (Col. 5, line 49-Col. 6, line 7).

Regarding claims 13 and 17, Shiota teaches all the claim subject matters as discussed above with respect to claims 7 and 10, Shiota further discloses *file names of the files in the second loadable and removable recording medium are such that the numerical characters of the file names of the files are consecutively numbered* (Col. 7, Lines 25-35).

Regarding claims 14 and 18, Shiota teaches all the claim subject matters as discussed above with respect to claims 13 and 17, Shiota further discloses *the numerical characters of the file names of the image files are consecutively numbered regardless even when image files from a plurality of first loadable and removable recording mediums are read out and recorded on the second loadable and removable recording medium* (Col. 7, Lines 25-35).

Regarding claims 15 and 19, Shiota teaches all the claim subject matters as discussed above with respect to claims 7 and 10, Shiota further discloses *the incrementing device always increments the last file-number by a predetermined amount* (Col. 7, Lines 20-39).

Regarding claims 16 and 20, Shiota teaches all the claim subject matters as discussed above with respect to claims 15 and 19, Shiota further discloses *the predetermined amount is 1* (Col. 7, Lines 20-39).

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Regarding claims 21 and 22, Shiota teaches all the claim subject matters as discussed above with respect to claims 7 and 10, Shiota further discloses the step of *directly reading out the files names of the image files recorded on the second loadable and removable recording medium* (Col. 7, Lines 40-46).

Regarding claims 23 and 24, Shiota teaches all the claim subject matters as discussed above with respect to claims 7 and 10, Shiota further discloses *the file name is unique to each image file stored in the second loadable and recording medium* (Col. 6, Lines 12-25, *flower0403* as the file name is unique to *flower04030002001* stored laboratory system).


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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM T. VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
HUNG Q PHAM  
Examiner  
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June 12, 2006